

**REMARKS**

Entry of the foregoing amendment and favorable reconsideration of the subject application in the light thereof are respectfully requested.

By the present amendment, claim 12 has been amended to recite that the method of treatment is for nocturnal gastroesophageal reflux disease or Barrett's oesophagus. It is believed that this amendment overcomes the section 112 rejection of record.

Turning now to the rejections of record, the initial rejection made by the Examiner is under 35 U.S.C § 112, second paragraph for the claims being indefinite. The Examiner states that claim 12 lacks clarity in that it is unclear whether or not a treatment of nocturnal gastroesophageal reflux disease or a treatment of Barrett's oesophagus is contemplated. It is submitted in light of the amendment to claim 12, appropriate clarification has now been made.

Accordingly, favorably reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C § 112 are therefore respectfully requested.

Claims 12-16 and 21 stand provisionally rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 7 and 9 of co-pending Application No. 10/561,844. Applicants will act on this rejection once allowable subject matter is agreed upon. At that time, Applicants will file a terminal disclaimer if appropriate.

Claims 12-16 and 21 also stand provisionally rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 14-20 of co-pending Application No. 11/344,212. Applicants will act on this rejection once allowable subject matter is determined. A terminal disclaimer will be filed at that time if appropriate.

Claims 12-16 and 21 also stand provisionally rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 16, 18 and 24-35 of co-pending Application No. 10/507,485. Applicants will act upon this rejection once allowable subject matter has been determined to exist. The filing of terminal disclaimer will be made at that time if appropriate.

Claims 12-16 and 21 also stand rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 8, 9 and 14-25 of U.S. Patent No. 7,034,038. In order to expedite prosecution, Applicants will submit a terminal disclaimer, as appropriate, after allowable subject matter has been agreed upon.

Applicants do note that the filing of a terminal disclaimer is not to be construed as an admission of the propriety of the rejection on obvious double patenting. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

Claims 12-16 and 21 also stand rejected under 35 U.S.C § 102 (c) by Barth et al. (U.S. Published Application 2006/0024238). For the following reasons, however, the Examiner's rejection is most respectfully traversed by Applicants.

Present independent claim 12 is directed to a method for the treatment of nocturnal gastroesophageal reflux or Barrett's oesphagus comprising administering a medicament comprising tenatoprazole.

The Barth reference does not disclose the administration of tenatoprazole for the treatment of nocturnal gastroesophageal reflux or Barrett's oesophagus. The effective U.S. filing date of the present application is October 21, 2002, due to a claim of priority to French Application No. 0213113. This first instance in which tenatoprazole is mentioned in the chain of Barth applications is in the International PCT application filed on May 16, 2003. Thus, there is no specific disclosure in the prior art of using tenatoprazole for the treatment of nocturnal gastroesophageal reflux and/or Barrett's oesophagus. The section 102 rejection should therefore be withdrawn.

The Examiner maintains, however, that in Provisional Application No. 60/404,154, filed August 19, 2002, that any proton pump inhibitor is encompassed in the teaching. Nowhere, however, is tenatoprazole mentioned. In fact, the pump inhibitors noted in the provisional applications from which Barth claims priority do not include tenatoprazole. The list of pump inhibitors is quite large, and therefore, a discussion that any pump inhibitor is contemplated cannot anticipate the claimed invention. Rather, one would have to look to the specific mention of tenatoprazole which occurred in the PCT Application filed subsequent to the priority document of the subsection application.

Furthermore, it is submitted that the prior art in no manner recognizes or discloses the advantages of using tenatoprazole. Accordingly, the suggestion of using any proton pump inhibitor would not render obvious the claimed subject matter in its use of specifically tenatoprazole.

For at least the foregoing, favorable, reconsideration and withdrawal of the Examiner's rejection over Barth et al. under 35 U.S.C. § 102(e) are therefore respectfully requested.

Lastly, Applicants wish that the Examiner contact the undersigned local representative of Applicants in order to conduct a personal interview. The Examiner may contact the undersigned at (202) 624-2546. Such a contact and granting of the request for an interview prior to acting on the subject Application would be greatly appreciated by Applicants. The Examiner is thanked in advanced for her consideration.

Favorable reconsideration of the foregoing remarks and the subject Application in the light thereof are respectfully requested.

If necessary for a timely response, this paper should be considered as a petition for an Extension of Time, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 104006.B130120).

Respectfully submitted,

May 26, 2009



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